

REMARKS

Upon entry of the present amendment, claims 1-19, 21, 24 and 25 will be pending in the application.

Claim 1 has been amended in accordance with the requirements of U.S. patent practice. In particular, claim 1 has been amended to include the limitation “wherein the (meth)acrylate (co)polymer is not formed in the presence of component (B).” Support is found at least in Preparation Example 1, “The Preparation of a Methacrylate Copolymer (A)” (p. 33, lines 8-29) in which no polyester is present. There is no teaching in the specification that the polyacrylate is formed in the presence of a polyester, and it is the normal and customary procedure for the skilled person in the art to prepare monomers for paint binders separately, and then mix them together.

Amendments to, cancellation of, and additions to, the claims, as set forth above, are made in order to streamline prosecution in this case by limiting examination and argument to certain claimed embodiments that presently are considered to be of immediate commercial significance. Amendment or cancellation of the claims is not in any manner intended to, and should not be construed to, waive Applicants' right in the future to seek such unamended or cancelled subject matter, or similar matter (whether in equivalent, broader, or narrower form) in the present application, and any continuation, divisional, continuation-in-part, RCE, or any other application claiming priority to or through the present application, nor in any manner to indicate an intention, expressed or implied, to surrender any equivalent to the claims as pending after such amendments or cancellations.

Reconsideration is respectfully requested in view of the foregoing amendments and following remarks.

1. **Rejection of claims 1-17, 19, 21, 24 and 25 under 35 U.S.C. 103(a) as being obvious over Neppi et al. (WO 2002/044235, wherein U.S. Publication No. 2004/0063851 is used as English equivalent), hereafter “Neppi” in view of Hoffmann et al. (U.S. Patent No. 5,326,820), hereafter “Hoffman”.**

The PTO acknowledges that Neppi “fails to teach a polyester and a molecular weight as well as a Tg of the acrylic polymer.” The basis of the rejection is therefore,

it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the coating composition taught by Neppi by replacing the acrylic copolymer component with the hydroxyl-containing component taught by Hoffmann so as to improve such properties as drying capacity, processibility, gloss stability, crack resistance, filling power, and flowability.

Applicants greatly appreciate the detailed basis of rejection but must respectfully disagree in regards to the invention of amended independent claim 1.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

This standard has not been met with the instant rejection.

First, the rejection presumes that the hydroxyl-containing component of Hoffmann is equivalent to limitations (A) and (B) of claim 1. However, this is not so. There are several differences between the hydroxyl-containing component of Hoffman and limitations (A) and (B) of Applicants' amended claim 1.

First, Hoffman does not teach the use of a polyester equivalent to Applicants' component (B) that has from 30 to 70 % by weight of cycloaliphatic structural units. The PTO attempts to say that Hoffman teaches that the cycloaliphatic content is from 5-100 mole% (col. 2, lines 30-40; col. 3, lines 28-33; col. 5, lines 64-68). However, what these sections of Hoffman say is that the polyester (A1) is made from components a), b), c), and d) wherein component a) is a polycarboxylic acid component. The relied upon sections of Hoffman merely state that 5-100 mole% of the carboxylic acid component employed be cycloaliphatic. Hoffman does not however, state how much of component a) be employed in making the polyester (A1). As a result, one of skill in the art cannot know the weight % of structural cycloaliphatic units desired or intended. Where the prior art gives no indication of which parameters are critical and no direction as to which of many possible choices is likely to be successful, the fact that the claimed combination

falls within the scope of possible combinations taught therein does not render it unpatentably obvious. *In re O'Farrell*, 7 U.S.P.Q 1673 (Fed. Cir. 1988).

Second, Hoffmann requires that the polyaddition resin (A2) (polyacrylate) is formed in the presence of polycondensation resin (A1) (polyester) (Abstract, col. 2, lines 55-58, and col. 6, lines 6-11), while claim 1 requires that the polyacrylate and polyester be prepared *separately*. According to the teaching of Hoffmann (col. 6, lines 6-11), “[i]t is *essential* to the invention that at least some of the polyaddition resin (A1) [A2 is meant] has been prepared in the presence of polycondensation resin (A1)” (emphasis added). In every example of Hoffmann, Copolymer Solution 1 through Copolymer Solution 6 (col. 13, line 14 to col. 16, line 15), the polyacrylate is formed *in the presence of* at least 600 g of polyester resin. In contrast, Claim 1 has been amended with the limitation that the (meth)acrylate (co)polymer is *not* formed in the presence of component (B), as is shown in Preparation Examples 1 and 2 on p. 33, line 8 to p. 34, line 20.

Third, both references are silent on the Tg of the polyacrylate, while Applicants' claim 1 requires a Tg of -15 to +70°C. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (C.C.P.A. 1974); MPEP 1243.03.

For all of the foregoing reasons, the combination of Neppi and Hoffmann does not supply all the limitations of claim 1 as herein amended.

With respect to motivation, the PTO alleges that the motivation for combining Neppi and Hoffmann is:

[t]he disclosed clearcoat, due to the combined use of the cycloaliphatic polyester and the polyacrylate, is said to be superior to conventional clearcoat because it has improved drying capacity and better processability (col. 1, line 37) as well as good stability of gloss, crack resistance, filling power, and good flow properties (col. 2, lines 1-15).

The skilled person in the art however, in order to achieve the cited properties, would be motivated to prepare the polyacrylate in the presence of the polyester, since Hoffmann expressly teaches this requirement. The skilled person would not be motivated to prepare the polyacrylate and polyester separately, as required by Applicants' claim 1.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc.*

v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984) Indeed, it is surprising, and in contrast to the teaching of Hoffmann, that it is not necessary that the polyacrylate be prepared in the presence of the polyester. The Applicants have surprisingly found that coatings of the invention had particularly good wetting, leveling, processing (p. 5, lines 30-34), and overcoatability properties (p. 6, lines 11-12) and exhibited excellent automotive quality (p. 6, lines 4-9) *without* preparing the polyacrylate component in the presence of the polyester.

Reconsideration and removal of the obviousness rejection of claim 1, claims 2-17, 19, 24 and 25, which depend therefrom, and claim 21, which incorporates all the limitations of claim 1, is respectfully requested in view of the foregoing amendment and remarks.

2. **Rejection of claim 18 under 35 U.S.C. 103(a) as being obvious over Neppl et al. (WO 2002/044235) in view of Hoffman et al. (U.S. Patent No. 5,326,820) as applied to claim 17 above, and further in view of O'Connor et al. (U.S. 5,521,272) hereafter "O'Connor".**

Applicants appreciate the detailed basis for rejection of claim 18, but this rejection is believed to be moot. Claim 18 depends from claim 1, which is believed to be patentable for the reasons set forth in Section 1 of this paper. Therefore, reconsideration and removal of the obviousness rejection of claim 18 is respectfully requested.

CONCLUSION

Applicants respectfully submit that the Application and pending claims are patentable in view of the foregoing remarks. A Notice of Allowance is respectfully requested. As always, the Examiner is encouraged to contact the Undersigned by telephone if direct conversation would be helpful.

Respectfully Submitted,

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